



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,662	02/04/2002	Alvin J. Glasky	370143.100	8319

7590 03/29/2005

ATTN: Louis C. Cullman  
OPPENHEIMER WOLFF & DONNELLY LLP  
Suite 700  
840 Newport Center Drive  
Newport Beach, CA 92660

EXAMINER

JIANG, SHAOJIA A

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/067,662

Applicant(s)

GLASKY ET AL.

Examiner

Shaojia A. Jiang

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 35-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/10/05</u> | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This Office Action is a response to Applicant's amendment and response filed on December 10, 2004 wherein claim 36 has been amended. Claims 1-34 have been cancelled previously.

Currently, claims 35-40 are pending in this application.

Claims 35-40 are examined on the merits herein.

This application is a CON of 08/878,656 06/19/1997 PAT 6,350,752 which is a CON of 08/492,929 07/20/1995 ABN, which is a CIP of 08/488,976 06/08/1995 PAT 5,801,184, which is a CIP of 08/280,719 07/25/1994 PAT 5,447,939.

The terminal disclaimer filed on December 10, 2004, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. 5,801,184 and 5,447,939 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Therefore, the obviousness-type double patenting rejections of record in the previous Office Action July 29, 2004, as being unpatentable over U.S. 5,801,184 and 5,447,939 are withdrawn.

Applicant's amendment changing the limitation to the single specific compound herein in the claims filed December 10, 2004 with respect to the rejection of claims 35-40 made under 35 U.S.C. 102(b) as being anticipated by Sham et al. of record stated in

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the Office Action dated July 29, 2004 has been considered and found persuasive to remove this particular rejection. Therefore, the said rejection is withdrawn.

The following is new rejection(s) necessitated by Applicant's amendment filed December 10, 2004.

Moreover, the following is new rejections necessitated by Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on December 10, 2004.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 35-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Glasky, Alvin J. (WO 91/14434 published 10/3/1991, equivalent to US 5091432, PTO-1449 submitted 12/10/2004).

Glasky discloses that administering to a mammal, the specific carbon monoxide dependent guanylyl cyclase modulating purine derivative, 4-[[3-(1,6-dihydro-6-oxo-9H-purin-9-yl)-1-oxopropyl]amino]- benzoic acid (also known as AIT 082 acid, see col.8 line 48-51; col.45, the 2<sup>nd</sup> last compound), is useful in a method for treating neuroimmunologic disorders or neurological disorders such as in mammals such as

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Alzheimer's disease (see abstract; col.2 line 35-65; col.4 line 1-9 and 50-52; claim 8 in particular). Glasky discloses that the effective amounts or doses of the specific carbon monoxide dependent guanylyl cyclase modulating purine derivative, 4-[[3-(1,6-dihydro-6-oxo-9H-purin-9-yl)-1-oxopropyl]amino]- benzoic acid, produces a treating concentration of at least 1  $\mu$ M (see Table 1-5 at col.31-33). Glasky discloses that the said mammal is treated by orally administering or injecting the compound such as AIT 082 (see col.4 line 50-52).

Therefore, Glasky anticipates Claims 35-40.

In view of the rejections to the pending claims set forth above, no claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on December 10, 2004 prompted the new ground(s) of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (571)272-0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Anna Jiang, Ph.D.  
Primary Examiner  
Art Unit 1617  
March 10, 2005

FORM PTO-1449  
(Modified)U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

ATTY. DOCKET NO.

105-072

SERIAL NO.

08/280,713

INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT

(Use several sheets if necessary)

DEC 10 2004

APPLICANT

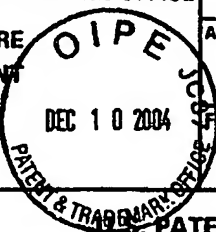
ALVIN J. GLASKY et al.

FILING DATE

July 25, 1994

GROUP

(37 CFR 1.98(b))



## U.S. PATENT DOCUMENTS

EXAMINER INITIAL		PATENT NUMBER							ISSUE DATE	PATENTEE	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
<i>SJD</i>	AA	5	0	9	1	4	3	2	02-25-92	GLASKY	A61K	31/52	03-28-90
	AB												
	AC												
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## FOREIGN PATENT OR PUBLISHED FOREIGN PATENT APPLICATION

		DOCUMENT NUMBER							PUBLICATION DATE	COUNTRY OR PATENT OFFICE	CLASS	SUBCLASS	TRANSLATION	
													YES	NO
	AL													
	AM													
	AN													
	AO													
	AP													

## OTHER DOCUMENTS (Including Author, Title, Date\*\*, Relevant Pages, Place of Publication\*\*\*)

<i>SJD</i>	AQ	Sylvain Lehmann et al., "Neurite outgrowth of neurons. . .guanidine group", <i>Neuroscience Letters</i> , 1993, 152:57-60, Elsevier Sci. Pub. Ireland Ltd.
	AR	Marcia Barinaga, "Carbon Monoxide: Killer to Brain Messenger in One Step", <i>Science</i> , 15 Jan 1993, 259:309.
<i>SJD</i>	AS	Ajay Verma et al., "Carbon Monoxide: A Putative Neural Messenger", <i>Science</i> , 15 Jan 1993, 259:381-384.

EXAMINER

DATE CONSIDERED

3/10/05

EXAMINER: Initial citation considered. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

\* Use publication date indicator on the patent or published application. 37 CFR 1.98(b).

\*\* The date should include at least the month and year for a foreign application. Notice of April 20, 1992 (1138 O.G. 37-41, 38).

\*\*\* "The place of publication" refers to the name of the journal, magazine or other publication in which the information being submitted was published. Notice of April 20, 1992 (1138 O.G. 37-41, 38).

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(Modified)U.S. DEPARTMENT OF COMMERCE  
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APPLICANT

ALVIN J. GLASKY et al.

FILING DATE

July 25, 1994

GROUP

(37 CFR 1.98(b))

## U.S. PATENT DOCUMENTS

EXAMINER INITIAL		PATENT NUMBER	ISSUE DATE	PATENTEE	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
	BA						
	BB						
	BC						
	BD						
	BE						
	BF						
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	BJ						
	BK						

## FOREIGN PATENT OR PUBLISHED FOREIGN PATENT APPLICATION

FOREIGN PATENT OR PUBLISHED FOREIGN PATENT APPLICATION														
		DOCUMENT NUMBER							PUBLICATION DATE	COUNTRY OR PATENT OFFICE	CLASS	SUBCLASS	TRANSLATION	
													YES	NO
	BL													
	BM													
	BN													
	BO													
	BP													

## OTHER DOCUMENTS (Including Author, Title, Date\*\*, Relevant Pages, Place of Publication\*\*\*)

SAJ	BQ	Min Zhuo et al., "Nitric Oxide and Carbon Monoxide. . .Hippocampus", <i>Science</i> , 25 June 1993, 260:1946-1950.
	BR	Ake Seiger et al., "Intracranial infusion of purified nerve. . .strategy" <i>Behavioral Brain Research</i> , 1993, 57:255-261.
SAJ	BS	Ateumi Nitta et al., "Effects of oral administration . . .in basal fore- brain-lesioned rats", <i>Eur. Journal of Pharmacology</i> , 1993, 250:23-30

EXAMINER

DATE CONSIDERED

3/10/05

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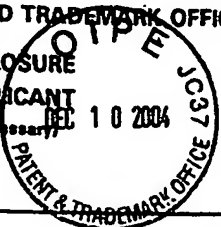
FORM PTO-1449  
(Modified)U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

ATTY. DOCKET NO.

105-072

SERIAL NO.

08/280,713

INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT  
(Use several sheets if necessary)

APPLICANT

ALVIN J. GLASKY et al.

FILING DATE

July 25, 1994

GROUP

(37 CFR 1.98(b))

## U.S. PATENT DOCUMENTS

EXAMINER INITIAL		PATENT NUMBER	ISSUE DATE	PATENTEE	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
	CA						
	CB						
	CC						
	CD						
	CE						
	CF						
	CG						
	CH						
	CI						
	CJ						
	CK						

## FOREIGN PATENT OR PUBLISHED FOREIGN PATENT APPLICATION

		DOCUMENT NUMBER	PUBLICATION DATE	COUNTRY OR PATENT OFFICE	CLASS	SUBCLASS	TRANSLATION	
							YES	NO
	CL							
	CM							
	CN							
	CO							
	CP							

## OTHER DOCUMENTS (Including Author, Title, Date\*\*, Relevant Pages, Place of Publication\*\*\*)

EXAMINER	CQ	M.H. Tuszynski & F.H. Gage, "Neurotrophic Factors and Neuronal Loss", Ch.25, <i>Alzheimer Disease</i> , R.D. Terry et al., eds., 1994, 405-417, Raven Press, NY
	CR	R.D. Hawkins et al., "Nitric Oxide and Carbon Monoxide. . .Long-Term Potentiation," <i>Journal of Neurobiology</i> , 1994, 25:6, pp. 652-665.
	CS	S.H. Snyder, "NO and CO: The Body's Unprecedented Signaling Molecules," <i>1995 Yearbook of Sci. &amp; the Future, Encyc.Brit.</i> , pp. 96-99.

DATE CONSIDERED

3/19/05

EXAMINER: Initial citation considered. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

\* Use publication date indicated on the patent or published application. 37 CFR 1.98(b).

\*\* The date should include at least the month and year for a foreign application. Notice of April 20, 1992 (1138 O.G. 37-41, 38).

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FORM PTO-1449  
(Rev. 2-32)U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

ATTY. DOCKET NO.

111-175

SERIAL NO.

08/488,976

INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT

(Use several sheets if necessary)

DEC 10 2004

APPLICANT

ALVIN J. GLASKY, ET AL.

FILING DATE

JUNE 8, 1995

GROUP

1205

## PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
520	AA	4 0 3 5 4 8 6	07/12/77	LABORIT	424	178	
	AB	5 0 9 1 4 3 2	02/25/92	GLASKY	514	262	
520	AC	5 2 5 6 6 7 7	10/26/93	SHAM, ET AL.	514	351	
	AD						
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## FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
							YES	NO
	AM							
	AN							
	AO							
	AP							
	AQ							

## OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

520	AR	Copy of the abstract from an article by E. G. Jung (Therapiewoch, Volume 34, No. 17, pages 2615-2618, 1984) entitled "CHEMOTHERAPIE MULTIPLER WARZEN MIT INOSIPLEX".
	AS	
	AT	

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

FORM PTO-692  
(REV. 2-92)

U.S. DEPARTMENT OF COMMERCE  
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DEC 10 2004

SERIAL NO.

08/280,713

GROUP/ART UNIT

1204

ATTACHMENT  
TO  
PAPER  
NUMBER

5

NOTICE OF REFERENCES CITED

APPLICANT(S)

GLASKY ET AL

U.S. PATENT DOCUMENTS

	DOCUMENT NO.	DATE	NAME	CLASS	SUB-CLASS	FILING DATE IF APPROPRIATE
A	4752693	8-1990	SIRCAN ET AL	544	277	
B	3321369	5-1967	GLASKY ET AL	167	65	
C	3438968	4-1969	GLASKY	260	211.5	
D	4221910	9-1980	SOROLLA	544	265	
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FOREIGN PATENT DOCUMENTS

	DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUB-CLASS	PERTINENT SMTS. DWG.	PP. SPEC.
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OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

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EXAMINER

DATE

A.C. Wesscott

3/6/94

S. J. 3/10/05

\* A copy of this reference is not being furnished with this office action.  
(See Manual of Patent Examining Procedure, section 707.05 (a).)

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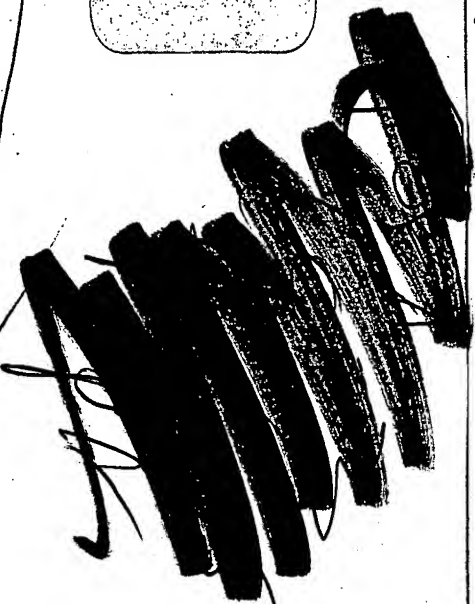
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